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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,832	01/22/2002	Stefan Pusch	112740-523	5764
29177	7590	08/26/2004	EXAMINER	
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			FERGUSON, KEITH	
			ART UNIT	PAPER NUMBER
			2683	

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/031,832

Applicant(s)

PUSL ET AL.

Examiner

Keith T. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20040818.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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DETAILED ACTION

*Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 6 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Green.

The claimed invention reads on Green as follows:

Regarding claim 6, Green discloses a communications terminal (mobile station) (fig. 2), comprising: a part (antenna/transceiver) for receiving messages (fig. 2 numbers 16 and 18), a part (antenna/transceiver) for transmitting messages (fig. 2 numbers 16 and 18), and parts (fig. 2 number 35) for interacting with a subscriber identity module (fig. 2 number 34) which can be exchanged by a user (col. 4 lines 25-27), the subscriber identity module having functions for compressing messages to be transmitted and for decompressing received messages (col. 2 lines 21-40 and col. 5 lines 40-58).

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Regarding claim 9, Green discloses a method (fig. 10 and fig. 11) for decompressing a received message in communications terminal (col. 2 lines 21-40 and col. 7 lines 1-41), the method comprising the steps of: detecting, with a device (SIM Processor for converting received data) of the communications terminal (col. 2 lines 19-34 and col. 7 lines 11-27), via a feature of the received message (col. 2 lines 19-34 and col. 7 lines 11-27), that the message is a compressed message (col. 2 lines 19-34 and col. 7 lines 11-27), and passing on the message, via a device of the terminal, to the subscriber identity module for decompression (col. 2 lines 19-48, col. 5 lines 40-58 and col. 7 lines 11-27).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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4. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green in view of Messiet.

Regarding claim 7, Green discloses a communications terminal as discussed supra in claim 6 above. Green differs from claim 7 of the present invention in that it does not disclose two different subscriber identity modules which can permit two different methods for at least one of compressing and decompressing messages to be carried out in conjunction with the same communication terminal. However, Green discloses one SIM card for compressing and decompressing messages to be carried out in conjunction with the same communication terminal (fig. 2 number 34 and col. 2 lines 20-40). Messiet teaches a mobile station (fig. 1 number 5) with two different SIM cards (fig. 1 number SIM 1 and SIM 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Green mobile station with two different subscriber identity modules which can permit two different methods for at least one of compressing and decompressing messages to be carried out in conjunction with the same communication terminal in order for the mobile station to store more compress data and decompress data when receiving and transmitting information to and from the SIM card, as taught by Messiet.

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Regarding claim 8, Green discloses wherein the functions for compressing and decompressing are carried out by one of devices (processor) (fig. 2 number 36 and col. 2 lines 20-40) and software objects (fig. 2 numbers 36 and 38) which are assigned to the subscriber identity module (fig. 1 number 34) and not to the communications terminal (fig. 2).

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Green in view of Novis et al..

Regarding claim 10, Green discloses a method (fig. 10 and fig. 11) for compressing a message in a communications terminal (col. 2 lines 21-40 and col. 7 lines 1-41), the method comprising the steps of: passing on a message to the subscriber identity module for compression (col. 2 lines 19-34 and col. 7 lines 11-27); compressing the message, via the subscriber identity module col. 2 lines 19-34 and col. 7 lines 11-27), using functions which are assigned to the subscriber identity (col. 2 lines 19-34 and col. 7 lines 11-27). Green differs from claim 10 of the present invention in that it does not explicitly disclose sending the message back to the communications terminal for transmission after compression. Novis et al. teaches a portable electronic device for transmitting information to and from a smart card for transmission (col. 4 lines 27-33). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Green with sending the message back to the communications terminal for transmission after compression in order to send a service provider software information stored within the SIM card of the mobile telephone in case of update software is needed, as taught by Novis et al..

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith T. Ferguson whose telephone number is (703) 305-4888. The examiner can normally be reached on 6:30am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Keith Ferguson  
Art Unit 2683  
August 18, 2004

